

### **REMARKS – General**

#### **Claim Rejections under 35 USC §103:**

Claims 1-2, 4-9, 24, 28, 31-32, 34, 36-38, 50, 55, 58, 61, 64, 66-70, 72-73 and 81 are rejected under 35 U.S.C. 103(a) as being obvious in view of U.S. Patent Application Publication No. 2006/0271993, App. No. 11/498,388 (published 11/30/2006) by Nakata et al. [hereinafter “Nakata”].

In previous Office Actions, Applicant faced rejections under 35 USC §102 in view of Nakata. Applicant successfully overcame those rejections by demonstrating that Applicant’s invention was capable of transferring monitoring of broadcast events between different clients operating in different communication systems. For example, a first client could be a mobile device operating in a cellular system, while a second client was a set-top box operating in a cable system. Applicant’s claimed invention advantageously allows monitoring to be transferred across both clients and communication systems so that a user can seamlessly transfer watching, for example, a television program from a television to a mobile telephone.

By contrast, Nakata teaches allowing a person to watch content on multiple devices when those devices are coupled to a single, wired bus. Namely, as demonstrated by Applicant, the system disclosed by Nakata is expressly tied to the Institute of Electrical and Electronics Engineers (IEEE) standard 1394. As set forth in this standard, which accompanied a previous response, the standard applies to devices that locally interconnected on a single, wired bus, such as within the home. Exemplary devices used with the 1394 standard include a camcorder, printer, personal computer, or monitor. With this system, “...a user who watched a program in a living room, for example, can continuously enjoy it in a bed room.” Nakata, paragraph [0113].

In the most recent Office Action, it is argued that Nakata renders Applicant’s claimed limitations obvious by way of its inclusion of paragraph [0112]. This is a boilerplate paragraph, which states the following:

[0112] In the above embodiments, the devices are interconnected using IEEE1394 interface in the AV system that incorporates the present invention. The present invention

is not limited to such a system. The present invention finds applications in a system that may be constructed of compact disk player, amplifiers, loudspeakers using a diversity of serial interfaces or parallel interfaces, and further in a variety of wire or wireless communication networks.

Applicant respectfully traverses the submission that the inclusion of this paragraph renders Applicant's claims obvious. Nakata teaches only a single embodiment in its disclosure. The singular embodiment requires a singular bus, operating in a singular system. Not only does Nakata only teach a singular embodiment using the IEEE 1394 standard, Nakata makes it clear that operation *hinges* upon this local, single bus configuration. As emphasized in Nakata at paragraph [0012], "[a]ccording to IEEE 1394...devices are connected in a tree structure in which one device is handled as a root device and then grand child devices connected under the root device." As set forth in Nakata at paragraph [0037], "The AV system comprises an optical disk device 2, and monitor devices 3A and 3B which are connected through a bus specified in IEEE 1394 to form a network." The wired necessity of Nakata is stated time and time again, as shown below (with emphasis added). See, e.g., paragraph [0002], paragraphs [0012]-[0013], paragraph [0018], and paragraphs [0040]-[0041]. The single bus configuration of Nakata requires operation within a *single system*. Any bus coupling elements, by definitions set forth in IEEE 1394 and by Nakata's disclosure, create a single system because all components in the system are expressly tied to the bus, receive the same communication signals as every other device, and are controlled or configured under a single device.

In teaching a single bus, Nakata teaches away from Applicant's invention. Paragraph [0112] of Nakata does nothing to correct the teaching away. Paragraph [0112] merely states that different types of serial connections or parallel connections could be made with the singular bus, and that the singular bus could be wired or wireless. Nothing in paragraph [0112] suggests that multiple busses or multiple communication systems can be used. The inclusion of paragraph [0112] in Nakata's disclosure provides no teaching whatsoever of transferring monitoring between *different systems*. All embodiments of Nakata still require a single bus in a single system. Nothing in paragraph [0112] provides a teaching of why this would not be the case.

According to MPEP §2141.02, “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *Id.*, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Moreover, “A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” MPEP §2144.05, citing *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

In the present case, the only embodiments explicitly taught by Nakata turn on the use of a single bus communication system. As noted, paragraph [0112] does nothing to correct this. By contrast, Applicant’s invention provides advantages over the teachings of Nakata because Applicant’s invention is capable of working among different systems, without the requirement of a common bus. This is true regardless of what type of serial or parallel interface is used in accordance with Nakata’s paragraph [0112], and also regardless of whether Nakata’s common bus is wired or wireless. Accordingly, the entirety of Nakata teaches away from Applicant’s invention recited in the independent claims, which transfers monitoring over multiple communication systems. For this reason alone, MPEP §2144.05 states that the rejection over Nakata is rebutted.

For the reasons above, Applicant respectfully submits that the rejections are overcome. Applicant respectfully requests reconsideration of the rejections in view of these comments.

Claim Rejections under 35 USC §103:

Claims 3, 33 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata in view of U.S. Patent Application Publication No. 2002/0049679, App. No. 09/827,469 (published 04/25/2002) by Russell et al. [hereinafter “Russell”].

Claims 10-23, 25-27, 29-30, 39-49, 51-54, 56-57, 59-60, 74-80, 82-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata in view of U.S. Patent Application Publication No. 2005/0028207, App. No. 10/925,826 (published 02/03/2005) by Finseth et al. [hereinafter “Finseth”].

Applicant has shown above that, Nakata fails to teach transferring a monitoring license from a first client to a second client, wherein the systems in which those clients operate is different.

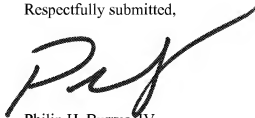
Regarding claims 3, 33, and 65, the addition of Russell fails to remedy this deficiency. Russell teaches only the transfer of a digital rights management key from one device to another. This device, as set forth by Russell at paragraph [0067] provides a secure environment for locally stored, licensed content to be executed. When combined with Nakata, the combination fails to teach the transfer of monitoring from one client to another, where those clients operate in different networks, because the combination requires the single system architecture of Nakata. It is not clear under the disclosed circumstances how the transfer of a digital rights management certificate between devices coupled to a common IEEE 1394-type bus would be beneficial, or how doing so would achieve Applicant's invention without disrupting the desired operation of the common IEEE 1394-type system existing in the primary reference. As such, the alleged motivation is suspect, as it does not appear relevant given the context of the primary reference. This is in addition to the failure to fully support and or describe either one or both of the reference make known or obvious each and every feature of claim 1, as noted above. Further, the combination teaches away from Applicant's invention in that Nakata teaches non-transfer of control. For these reasons, Applicant respectfully requests reconsideration of the rejection to claims 3, 33, and 65.

Regarding claims 10-23, 25-27, 29-30, 39-49, 51-54, 56-57, 59-60, independent claim 62, claims 63, 74-80, 82-86, Applicant respectfully submits that the addition of Finseth to Nakata also fails to remedy the deficiencies set forth above. The combination of Finseth and Nakata both fails to teach and teaches away from Applicant's invention as does the combination of Russell and Nakata. For these reasons, Applicant respectfully requests reconsideration of the rejections to these claims.

**CONCLUSION**

For the above reasons, Applicant believes the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicant believes this application is now in condition for allowance, for which it respectfully submits.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Burrus', with a long, sweeping horizontal stroke extending to the right.

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